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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/853,787      | 05/14/2001  | Akihisa Murata       | Q64434              | 7102             |

7590 08/01/2002

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EXAMINER

ZIRKER, DANIEL R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1771

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DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3, 5
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The Examiner wishes to acknowledge receipt of applicants' formal drawings submitted on August 23, 2001.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Japanese Patent Abstract 11 166164 or applicants' admissions regarding the prior art on page 1 of the specification taken in view of Derwent Abstract XP-002191577. JP -164 discloses a thermally releasable pressure sensitive adhesive sheet comprising a thermally expandable microsphere-containing pressure sensitive adhesive layer coated onto a suitable base and which optionally additionally employs a rubber-like organic elastic layer such as applicants claim in their claim 4. Additionally, applicant appears to admit on page 1 of the specification that heat peelable pressure sensitive adhesive sheets can comprise a suitable adhesive coated onto a substrate, the adhesive comprising heat-expandable microspheres and which results in an adhesive sheet that can be easily peeled from the

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adherend. The primary references each lack a teaching of the claimed surface resistivity performance parameter, i.e. a minimal level of antistatic behavior. The secondary reference, however discloses a pressure sensitive adhesive composition which exhibits surface resistivity values when coated onto a suitable backing, i.e. polyester film, of the range which applicants contemplate. Additionally, the reference is suitable for surface protection of electronic parts in elevated temperature operations such as applicants appear to contemplate. The secondary reference lacks a teaching regarding how the surface resistivity performance parameter is obtained when coated onto a suitable film such as a polyester. That is, the reference is not enabling with respect to how to attain the low antistatic values it claims to teach. The Examiner, however, believes that attaining such a performance parameter is both well known to one of ordinary skill in the art, and also notes that Gutman et al., U.S. 5,508,107, cited as evidence of the state of the art appears to teach (note particularly column 1 line 65 - column 2 line 18, column 4 lines 53-55) that antistatic adhesive compositions and accompanying adhesive tapes in other related applications are well known in the art of transport of electrical current or prevention of electrostatic charge. Accordingly, one of ordinary skill, motivated by an expectation of improved adhesive tape performance in the art of surface protection of electronic parts where high

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temperatures are routinely encountered would have more than ample motivation to incorporate the teachings of XP -577 regarding the surface resistivity values, which are attainable by one of ordinary skill in the art.

With respect to the dependent claims, note that the roughness parameter of applicants' claims 2 and 3 is also believed to be a well known variable to one of ordinary skill in the art; alternatively, note as evidence of the state of the art U.S. Patent Application Publication 2001/0020515A1 to Shibata et al., particularly at page 2, paragraph 12 wherein it is taught that pressure sensitive adhesive layers often exhibit surface roughness of 1 micron or finer that are formed by suitable known surface modification treatments, and by doing so improve the resulting bonding properties of the protective or release sheet to the adhesive layer. Finally, it is further believed that JP Abstract -164 clearly teaches the rubber-like organic elastic layer set forth in applicants' claims 4 and 5.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Darvell et al., Levens, and Wang.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

July 25, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1800~~  
1700

*Daniel Zinker*